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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,783	06/27/2001	Frank Bahren	Westphal.6313	9614

7590 10/26/2006

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,783

Applicant(s)

BAHREN ET AL.

Examiner

Dohm Chankong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 10-14, 18-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10-14, 18-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/22/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- 1> This action is in response to Applicant's remarks, filed 8.18.2006. Claims 7, 10-14, 18-23 and 25 are presented for further examination.
- 2> This is a final rejection.

Response to Arguments

I. APPLICANT'S ARGUMENTS HAVE BEEN CONSIDERED BUT ARE NOT PERSUASIVE.

Applicant argues in substance that a prima facie case of obviousness has not been established in combining the Ford and Koning references. Applicant asserts that there is no suggestion or motivation to combine the references because there are significant distinctions between the types of problems solved in Ford and Koning. For the reasons set forth below, the Office respectfully disagrees.

A. Applicant's characterization of Koning is inaccurate because Koning expressly teaches generating multiple addresses for a single device.

Applicant's characterization of the Koning reference is inaccurate. Applicant's primary argument is that Koning does not teach how to derive a second address from a first address for a single device; Applicant argues that Koning merely teaches a single address for each network device. However, Koning expressly contradicts Applicant's argument. First, Koning discloses "[a] processor uses the first address value to derive a second address value from a second, different block of preferably consecutive address values, and then assigns both" (emphasis added) [abstract]. Further, these address values "can be used subsequently for identification purposes, e.g., as source or destination addresses for purposes of

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communication” [column 2 «lines 16-20»]. Further, “[t]his embodiment of the invention is particularly suited for use wherever two addresses are required” [column 2 «lines 35-38»]. In other words, Koning’s invention provides “any number of addresses can be made available for use by the device” [column 2 «lines 60-62»]. Thus, contrary to Applicant’s arguments, Koning is entirely focused on generating multiple addresses for a single device.

B. The motivation to combine comes expressly from Koning because Koning recognized an advantage in combining the claimed feature with Ford.

The motivation to combine the references is suggested by Koning. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983).

Here, Koning teaches that the functionality of generating a second address from a first address for a single device is beneficial because “expands and [sic] the stored address information into a complete set of addresses” [column 2 «lines 15-16»]. Further:

“any number of addresses can be made available for use by the device. This embodiment thus provides maximal flexibility in the number of addresses that the address memory can be made to specify, and efficiency in the use of address memory space, while using address memory chips requiring minimal changes from existing designs and manufacturing techniques” [column 2 «lines 61-68»].

In other words, there is a clear recognition in Koning that there is an expected beneficial result from the functionality. As the Koning and Ford are related towards the same invention, it would have been obvious to incorporate Koning’s features into Ford for the advantages discussed above.

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- C. Applicant's analysis is further erroneous because the test for combining references is what the references would have suggested to one of ordinary skill in the art.

Finally, even if Applicant's characterization of Koning is accurate (which it is not), Applicant's argument is still unsound because the test is not whether Koning, as the secondary reference, teaches all the elements of the claim. The test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425 (CCPA 1981).

Here, Koning was relied upon to teach the specific feature of manipulating the first address by mathematically summing the first address with a predetermined number, the sum representing the second address. Ford already taught all the other the features including the feature whereby a network device utilized a first address in one network and a second address in a different network. Thus, Applicant's focus on whether or not Koning teaches that particular claimed element is immaterial to the construction of the rejection. That is, since Ford teaches all but one of the claimed elements, it is of no consequence whether or not Koning's devices have a single address or multiple addresses.

What matters is if Koning suggested or taught the claimed element not taught by Ford. The Office asserts, and Applicant does not seem to contest, that Koning does suggest the feature and further suggests that such a combination would be desirable because, as discussed above, it would increase the address space of a communication device without the need of pre-programming the device with multiple addresses. Therefore, incorporating Koning's teachings into Ford's system would be highly desirable.

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II. CONCLUSION

Applicant's arguments have been carefully considered, but based on the aforementioned reasons, they are not deemed persuasive. The rejections set forth in the action filed 4.12.2006 are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3> The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action [see non-final rejection, filed 4.12.2006].

4> Claims 7, 10, 12, 14, 18 and 20 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ford et al, U.S Patent No. 6.101.499 ["Ford"] in view of Koning et al, U.S Patent No. 5.731.868 ["Koning"].

5> Claims 11 and 19 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ford and Koning, in further view of the MOST Specification Framework Rev 1.1 ["MOST spec"].

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6> Claims 13 and 21 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ford, Koning and the MOST spec, in further view of Inoue et al, U.S Patent No. 6,163,843 [“Inoue”].

7> Claim 22 is rejected under 35 U.S.C § 103(a) as being unpatentable over the MOST spec, in view of Ford, in further view of Koning.

8> Claims 23 and 25 are rejected under 35 U.S.C § 103(a) as being unpatentable over the MOST spec, Ford and Koning, in further view of Inoue.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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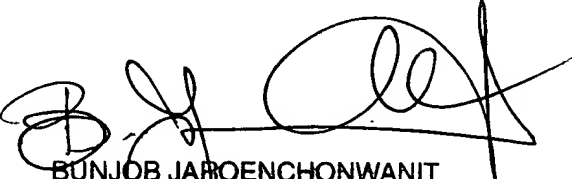
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER